

REMARKS

The only issue outstanding in the Office Action mailed February 26, 2002, is the rejection of all claims under 35 U.S.C. §103. Reconsideration of this rejection, in view of the following discussion, is respectfully requested.

As will be recalled, Flesher discloses a polyetheresteramide, and water vapor permeable films thereof. Patentees teach that these films are used in "many application[sic] and especially for composite articles and objects provided with such film(s) and intended for contact with the human or animal body." Patentees list, in particular, manufacture of clothing, footwear, adhesive or non-adhesive dressings, or compresses and linen employed in operating units, as well as hardware supports for curative or preventative medications administered subcutaneously. Patentees further indicate that the films may be used in the manufacturing of seats such as motor vehicle seats or under roofing materials in order to increase leak proofing of the roof without retaining moisture. See column 3, lines 20-60.

Werenicz discloses a polyurethane-based film, which is water permeable, and teaches that the film may be used in "applications in which water-vapor permeability is desirable." See column 1, lines 23-26. Patentees teach that these applications include weatherproof clothing and tarpaulins, and "in the construction industry." See column 1, lines 21-24.

WO 96/15174 discloses polyethers used in biodegradable moldings, adhesives, foams and blends with starch. See the abstract.

Thus, as admitted in the office action, these references fail to suggest the use of their films in the production of covers for composting. In order to remedy this deficiency, the office action now cites Tesch. However, the films disclosed in therein have significant differences from those of the primary references. While the Office Action argues that "Tesch advises, but does not necessarily require, that slits within the film be used to control [oxygen or air permeability]," in fact, patentees clearly teach that slitting of the film is *necessary* where gas permeability is desired. For example, patentees teach that it is "desirable, if not necessary, to appropriately slit the web *to allow appropriate transfer of gases.*" See col. 4, lines 58-62. Patentees teach that air permeability "is provided in the polymeric sheet by a precisely

controlled slitting operation or in the fiber sheet by control of, for example, the degree of compression during fabrication." See col. 3, lines 65-end. This "fiber sheet" is the embodiment which may not be slitted according to patentees, although patentees teach that slitting may be performed on the fiber sheet to *increase* permeability. See col. 6, lines 65-66. The fiber sheet, which is spun-fleece, etc. , see col. 6, line 50, is not equivalent to the materials of the primary reference or the present claims, which are polymeric in nature, and it appears that permeability is introduced into the fiber by producing an open weave by controlling the degree of compression, see col. 3, lines 65-end. Thus, patentees clearly teach that, *for polymeric webs*, slitting is necessary to control moisture. See col. 3, lines 65-66. Thus, Tesch is consistent with Pia cited in the previous Office Action, which taught that perforations were necessary in polymeric film in order to achieve desired permeability. Tesch clearly teaches the same is necessary where polymeric films are employed.

It is argued in the present Office Action, that the present claims do not exclude pierced or slitted films. However, the present claims are directed to films which are "water impermeable," but have water vapor permeability. See page 2, the third full paragraph of the present specification. It is submitted that the amendment to the present claims clarifies the water impermeable nature of the films, but recites an inherent characteristic thereof and thus, does not limit the claims either literally, or for purposes of the doctrine of equivalents, over the prior language.

It is moreover submitted that the primary reference and the secondary reference are non-analogous art and would not be combined by one of ordinary skill in the art. The test for non-analogous art is set forth in *In re Clay*, 966 F.2d 656, 23 USPQ2d, 1058 (Fed. Cir. 1992), where the Federal Circuit indicated that there is a two step test to determine whether references are combinable. First, one must inquire whether the references are in the same field of endeavor. It is clear that, in the present situation, they are not. As noted above, the primary references disclose clothing, foot wear, adhesive dressing, motor vehicle seats, roofing materials, weather proof clothing, tarplins in the construction industry, biodegradable molding and adhesives, etc. Thus, the primary references are not directed to the specific needs of composting, unlike the secondary reference. It is noted that the mere fact that the primary references are arguably

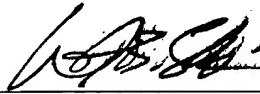
directed to polymeric sheets in which water permeability might be a concern, is insufficient to place the references in the category of analogous art. For example, in *Clay, supra*, the Federal Circuit found that injecting gel into an oil tank to remove dead space was *not* equivalent to injecting gel into a subterranean reservoir to flush out oil, although it clearly could have been argued (and was, by the PTO), that both references were directed to injecting gel into a space to flush out oil. However, the Federal Circuit found that different concerns would be encountered by artisans in both areas and, thus, the art was not analogous. The same is the situation here, where the primary reference is not concerned with the exacting permeability needs of composting, and the secondary reference is unconcerned with the specific permeability needs of shoes and roofing, etc.

The second portion of the *Clay* test is whether the references are "reasonably pertinent to the same problem." As can be seen from the above discussion, they are not, in view of the differing concerns in composting versus the other applications enumerated above. Thus, it is submitted that the references are in non-analogous areas, and would not be combined by one of ordinary skill in the art. In conclusion, it is respectfully submitted that the references fail to support a rejection under 35 U.S.C. §103, and withdrawal of the rejection is therefore respectfully requested.

The claims of the application are submitted to be in condition for allowance. However, should the Examiner have any questions or comments, he is cordially invited to telephone the undersigned at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Harry B. Shubin (Reg. No. 32,004)
Attorney/Agent for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

FILED: July 28, 2003

K:\Atocm\100-199\163\REPLY-002.doc

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Services as First Class Mail in an envelope addressed to:
Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on: 7/28/03
Name: Blaine B. Shubin
Signature: Blaine B. Shubin